



UNITED STATES PATENT AND TRADEMARK OFFICE

BT

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,179	03/12/2004	Manoj Kumar	DOC0057PA/DC5074/GC792-4	8989

7590 11/01/2005

DINSMORE & SHOHL LLP
One Dayton Centre
Suite 500
One South Main Street
Dayton, OH 45402-2023

EXAMINER

KOSAR, ANDREW D

ART UNIT PAPER NUMBER

1654

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/800,179

Applicant(s)

KUMAR ET AL.

Examiner

Andrew D. Kosar

Art Unit

1654

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended. .
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: 15.
Claim(s) rejected: 1-4, 8, 9, 12-14 and 31.
Claim(s) withdrawn from consideration: 5-7, 10, 11, 16-30, 32 and 33.


AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.


ANISH GUPTA
PRIMARY EXAMINER

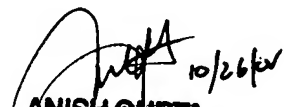

Andrew D. Kosar, Ph.D.
Art Unit 1654

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's elected species had been properly identified as being free of the art (see Office Action 1/25/2005, page 2-last line to page 3-5th line). The examiner extended the search and did not, as Applicant asserts 'elect a different species for Applicant'- as is proper under MPEP 803.02, which states, "On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final." Applicant, in response to the First Office Action of 1/25/05, amended the claims, thus overcoming the art rejection- and not due to a 'persuasive traversal'- the rejection of the claims was rendered moot, and a new grounds of rejection was necessitated. In conforming with the practice of MPEP 803.02, the search was again extended to a new species, and claims not drawn to the new species - which was necessitated by Applicant's amendment, were properly withdrawn from consideration. The rejection was properly made final, necessitated by Applicant's amendments to the claims, in accordance with MPEP 803.02.

Applicant's reliance on MPEP 818.01 is improperly directed at the Examiner's extension of the search, as MPEP 818.01 is directed towards Applicant's elected species and APPLICANT'S binding election, which does not allow APPLICANT to change inventions, i.e.- elect a new species after an Action on the Merits has been issued. It is noted, again, Applicant's elected species was indicated by the Examiner as to be free of the prior art. The Examiner extended the search properly, as in accordance with MPEP 803.02. Applicant's reliance upon MPEP 706.07(a) is improper, as the finality of the rejection was, contrary to Applicant's assertion, necessitated by Applicant's amendments to the claims. Applicant is directed towards, e.g., the LAST two lines of amended claim 1, which were not present in the original claims, and Applicant is further directed to Applicant's response (4/27/05) page 17, lines 5-10 where Applicant highlights the statement "...adapted to provide..." as what Coleman fails to teach.

With regards to the rejection of claims under 35 USC 102(b), the rejection is maintained for the reasons of record. The examiner maintains that the rejection is properly anticipatory, regardless of the number of references- e.g. Voet, which teaches an inherent property of a well-known compound.

Continuation of 13. Other: Applicant's amendment to the specification, filed 10/18/2005, identifying a collaboration under the CREATE Act, is acknowledged and has been entered, as it does not affect the disposition of the claims. Applicant has not amended the claims.


ANISH GUPTA
PRIMARY EXAMINER